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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,811	04/15/2004	Yen-Fu Chen	AUS920031072US1	6690

37945 7590 02/03/2010
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EXAMINER

BELANI, KISHIN G

ART UNIT	PAPER NUMBER
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2443

NOTIFICATION DATE	DELIVERY MODE
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02/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/824,811	Applicant(s) CHEN ET AL.	
	Examiner KISHIN G. BELANI	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-40,42,43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 40 and 42 is/are allowed.
- 6) ☒ Claim(s) 37,39,43 and 45 is/are rejected.
- 7) ☒ Claim(s) 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/16/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicant's amendment filed on 11/13/2009. **Claims 37, 39, 40, and 43** have been amended. **Claims 41 and 44 have been cancelled.** **Claims 37-40, 42, 43 and 45** are currently pending in the present application. The applicants' amendments to claims are shown in ***bold and italics*** and the examiner's response to claim amendments is shown in **bold in this office action**. **This Action is made FINAL.**

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 43 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 43 recites a computer program product that includes a computer readable medium which appears to cover both transitory and non-transitory embodiments. The United States Patent and Trademark Office (USPTO) is required to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media **and** transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The Examiner suggests that the Applicants add the limitation "non-transitory computer readable storage" to the claim(s) in order to properly render the claims in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification.

Claim 45 is rejected based on its dependency on the rejected base claim 43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Brown et al. (US Patent Application Publication # 2003/0023684 A1)** in view of **Briggs et al. (US Patent Publication # 7,080,139 B1)** and further in view of **Bogard (US Patent Publication 6,757,365 B1)**.

Consider **claim 37**, Brown et al. show and disclose a computer implemented method, comprising:
responsive to a first input to a computer by a first user of an instant messaging service adapted for sending and receiving a plurality of text messages in real time between the first user and a second user, determining, by a processor of the computer, ***based only on the first input***, that a topic tag is to be inserted into a text message of an instant messaging session, wherein the instant messaging service is adapted to accept the first input before the instant messaging session begins, during the instant messaging session, and after the instant messaging session; and responsive to the acceptance, automatically inserting the topic tag, by the processor, into the text of the instant messaging session (Fig. 2 that shows an instant messaging service adapted for sending and receiving a plurality of text messages in real time between the first user and a

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second user; paragraph 0063 describes the details of the messaging service; Fig.3 that shows the details of the messaging server 50, including a messaging controller 62; and **paragraph 0073 which teaches that a sending user (a first user) may select the attributes for a particular topic (a first input) and then initiate that topic**; further disclosing that the messaging controller 62 allows users to customize messaging output before, during, and after a session; paragraph 0069 which further discloses that as messaging server 50 receives messages (i.e. after the second user's response of accepting the first user's selected topic), they are stored according to channel, topic, and sending user and then distributed to each of the receiving users participating in that channel; paragraph 0074 which teaches that multiple windows each associated with a particular topic may be initiated between two users participating in the instant messaging session, wherein a window associated with a particular topic may be left open, but may be indicated as an old conversation, while a new topic window may be designated as a new conversation, and flowchart of Fig. 4 with paragraphs 0075-0077 which disclose that addition of a new topic requires comparing the new topic with current topics open in the current channel, and if the new topic does not match any of the current topics, adding the new topic tag to the channel, thereby disclosing that responsive to a first input to a computer by a first user, determining, by a processor of the computer, that a topic tag is to be inserted into a text message).

However, Brown et al. do not specifically disclose responsive to a second input to the computer by the second user, determining by the processor, **one of** an acceptance **and a rejection** of the topic tag by the second user; when a turn is identified by the

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processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements; ***and responsive to the rejection, continuing the instant messaging session without an insertion of the topic tag.***

In the same field of endeavor, Briggs et al. show and disclose the claimed method (and apparatus and computer program product), wherein responsive to a second input to the computer by the second user, determining by the processor, ***one of an acceptance and a rejection*** of the topic tag by the second user (Fig. 8D that shows a topic sharing interface, with topics/subtopic list 892 and checkboxes 891 that any receiving user may click in to indicate to the processor an acceptable topic, or check it off to reject the topic previously selected by another user; column 8, lines 42-45 which disclose that each user will be able to turn the displayed topic areas on or off; ***since the claim requires response for only one of an acceptance and a rejection, the examiner has elected to respond to the acceptance portion only***).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine, by the processor, responsive to a second input to the computer by the second user, one of an acceptance and a rejection of the topic tag by the second user, as taught by Briggs et al., in the method (and apparatus and computer program product) of Brown et al., so that an instant messaging session with the mutually acceptable topic identified in a new topic window may be started.

However, Brown et al., as modified by Briggs et al., do not specifically disclose when a turn is identified by the processor, wherein a turn means a shift in a textual

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communication during the instant messaging session indicated by a plurality of successive statements.

In the same field of endeavor, Bogard shows and discloses the claimed method (and apparatus and computer program product), including when a turn is identified by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements (column 10, lines 19-38 which show how an introductory conversation topic about using a particular instant messaging service turns to a registration topic when the customer responds with a “No” to a question from the system), wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements about the registration process).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify a turn by the processor, wherein a turn means a shift in a textual communication during the instant messaging session indicated by a plurality of successive statements, as taught by Bogard, in the method (and apparatus and computer program product) of Brown et al., as modified by Briggs et al., so as to mark different topics of discussion in order to later identify and understand which topics were discussed during the session.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Brown et al. (US Patent Application Publication # 2003/0023684 A1)** in view of **Briggs et al. (US Patent Publication # 7,080,139 B1)** and further in view of **Bogard (US Patent**

Publication # 6,757,365 B1) and further in view of **St. John et al. (US Patent Application Publication # 2006/0004702 A1).**

Consider **claims 39**, and **as it applies to claim 37 above**, Brown et al., as modified by Briggs et al., and Bogard, further show and disclose the claimed method, further comprising:

saving a transcript of the instant messaging session to a repository (in Brown et al. reference, Fig. 8, block 266 that shows storing message in temporary message file before formatting and distributing the message; paragraph 0091 discloses the same details); and

searching the repository for the topic tag (Fig. 3, Search entry window 371 and Search (Find) button 372 that are used to enter topic tag by the user, and based on the tag entered, the repository is searched for the content associated with the tag; also Fig. 9, messages tab 965 that provides access to the message repository; filters 971-973 that provide for a narrower focused search; column 6, lines 37-51 and column 8, line 56 through column 9, line 14 disclose the same details).

However, Brown et al., as modified by Briggs et al., and Bogard, do not explicitly disclose that responsive to determining that there is a match between the topic tag in the repository and an entry in an auto alert table, exporting an associated transcript segment to an e-mail.

In the same field of endeavor, St. John et al. further show and disclose the claimed method (and apparatus and computer program product), wherein responsive to

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determining that there is a match between the topic tag in the repository and an entry in an auto alert table, exporting an associated transcript segment to an e-mail (Fig. 1, Active DB 14 and Fig. 6; paragraphs 0061-0063 which disclose that information items and their associated gists are stored in database 14, wherein each client can query (scanning topic tags) the database to obtain information about the topics of interest to the client; further disclosing handling auto alerts by the document server 8, wherein the auto alert contains at least the item identifier of the involved information item and the category of the terms that trigger the auto alert, and the client manager searches the client profiles (auto-alert tables) to identify each client to whom the identified item is to sent, and further indicating that the auto-alert message may take the form of an e-mail containing the information item).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to export, responsive to determining that there is a match between the topic tag in the repository and an entry in an auto alert table, an associated transcript segment to an e-mail, as taught by St. John et al., in the method (and apparatus and computer program product) of Brown et al., as modified by Briggs et al., and Bogard, in order to deliver the information for the selected topic to each user who requested the information.

Allowable Subject Matter

Claims 40 and 42 are allowable. Claim 38 is objected to as being dependent upon rejected base claim 37, but would be allowable if rewritten in independent form

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including all of the limitations of the base claim and any intervening claims.

Furthermore, **claims 43 and 45, currently rejected under 35 USC 101, would also be allowable, if the claim text is modified to overcome the rejection under 35 USC 101.**

The following is a statement of reasons for the indication of allowable subject matter:

Consider **claims 38, 40, 42, 43, and 45**. The best prior art found during the examination of the present application, **Brown et al. (US Patent Application Publication # 2003/0023684 A1)**, **Briggs et al. (US Patent Publication # 7,080,139 B1)**, and **Bogard (US Patent Publication 6,757,365 B1)**, fail to disclose the graphical user interface described in claims 38, 41, and 44. Specifically, none of the cited prior art shows, describes, or suggests four different areas for displaying the chat transcript of the instant messaging session in the first area, with a topic list at the end of the chat transcript and two sub-topic tabs, such that when a topic from the displayed topic list is selected, the corresponding instant message transcript segment is shown in the second area; when the first sub-topic tab is selected, the corresponding instant message transcript segment is shown in the third area, and when the second sub-topic tab is selected, the corresponding instant message transcript segment is shown in the fourth area.

Therefore, claims 40 and 42 are considered novel and non-obvious, and therefore allowable. Claim 38 will be allowable if written in independent form including all of the limitations of the base claim 37. Also, claims 43 and 45 would become

allowable, if the claim text “computer readable storage” of claim 43 is modified to “non-transitory computer readable storage”, as explained in the 35 USC 101 rejections for claims 43 and 45.

Response to Arguments

Applicants’ arguments filed 11/13/2009 have been fully considered but they are not persuasive. The examiner has carefully reviewed the amended claims and the cited prior art, and has concluded that the cited references do teach each and every amended claim feature of the rejected claims, which are deemed obvious and therefore not allowable. The examiner’s response to applicants’ argument is shown below:

Consider **independent claim 37**. On page 9 of the “Remarks” section, the applicants argue that the amended claim text “based solely on the first input”, is not taught by the cited Brown et al. reference, because Brown et al. teaches adding a topic based on a comparison of a topic. Therefore, Brown et al. cannot determine that a topic tag is to be inserted by a processor using only the first input. The examiner respectfully disagrees with this assertion. The context in which Brown et al. use comparison, involves a channel containing an old conversation with an assigned topic tag. When that conversation leads to a new conversation (similar to a turn), the system must determine if the new conversation is really a new topic, or continuation of an old conversation. A new topic tag is assigned, when the system determines that the new conversation does not fit any of the existing tagged conversations currently open. A comparison is not needed if only a single topic of conversation is currently active.

Paragraph 0073 of Brown et al. clearly states that “a sending user may select the attributes for a particular topic and then initiate that topic”, which was cited in the rejection of claim 37 in the previous office action dated 08/21/2009.

On page 10 of the “Remarks” section, the applicants argue that the cited Briggs et al. reference does not show or disclose the claim element “determining, by the processor, an acceptance of a topic tag by the second user”. The applicants argue that Fig. 8D in the Briggs et al. reference does not show and column 8, lines 42-45 do not disclose the claimed element “an acceptance of the topic tag inserted into the text in response to the first input”. Again, the examiner begs to differ with this interpretation of the Briggs et al. teachings. As broadly interpreted by the examiner, Fig. 8D shows a “Topic Sharing” tag highlighted. This topic sharing interface is shown to all participants, including the first and the second user. If a first user checks a checkbox to indicate his/her preference for initiating a topic, the system displays that selection to the second user, who may or may not agree with the selection. If the second user agrees with the selection, he/she will leave the same checkbox checked. The conversation topic tag will then correspond to the text associated with the checked checkbox. The second user need not specifically type in his/her topic tag text. The description on top of Fig. 8D can also be broadly interpreted as outlined by the examiner. Furthermore, if the second user unchecks the checkbox selected by the first user, indicating rejection of the topic, no topic tag may be inserted in the conversation. However, since the claim requires “**only one of** an acceptance and a rejection”, the examiner has elected to respond to acceptance option only.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Friday from 6:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-0800.

/K. G. B./
Examiner, Art Unit 2443

January 22, 2010

/George C Neurauter, Jr./
Primary Examiner, Art Unit 2443